


CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date: July 26, 2007 Name: Tadashi Horie Reg. No. 40,437 Signature: 

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Masaaki YAMAMOTO et al.

Appln. No.: 09/720,729

Filed: December 27, 2000

For: MOBILE COMMUNICATION TERMINAL

Examiner: LY, Nghi H.

Art Unit: 2617

Attorney Docket No: 9683/74

Mail Stop Response to Office Action
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Transmittal (in duplicate); Supplemental Response to Office Action (4 Pages); Declaration of Mr. Masaaki Yamamoto (2 Pages – executed)
- ☒ Return Receipt Postcard

Fee calculation:

- ☒ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).
- ☐ A petition or processing fee in an amount of \$_____ under 37 C.F.R. § 1.17(_____).
- ☐ An additional filing fee has been calculated as shown below:

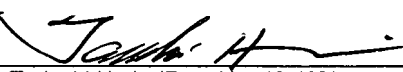
					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			X100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+ \$360=	
					Total	\$		Total	\$

Fee payment:

- ☐ A check in the amount of \$_____ is enclosed.
- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$_____. A copy of this Transmittal is enclosed for this purpose.
- ☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

July 26, 2007
Date


Tadashi Horie (Reg. No. 40,437)



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on July 26, 2007

Date of Deposit

Tadashi Horie, Reg. No. 40,437

Name of applicant, assignee or

Registered Representative

Tadashi Horie

Signature

July 26, 2007

Date of Signature

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SUPPLEMENTAL RESPONSE TO OFFICE ACTION

Mail Stop Response to Office Action

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

In reply to the Office Action dated January 26, 2007, Applicants timely submitted the response on July 25, 2007. Applicants hereby submit a declaration by Mr. Masaaki Yamamoto under 37 C.F.R. 1.132 to supplement the July 25, 2007 response.

The registration control is a patentable feature.

In the response submitted on July 25, 2007, Applicants concluded that Wells and Nishino, even if combined, fail to disclose or teach the registration control. Applicants would like to emphasize that the registration control was not an obvious feature to one of ordinary skill in the art at the time the invention was made. When the invention was made, a person of ordinary skill who had a wireless terminal with the Internet access capability would not have been motivated to selectively register images for later display in the context of browsing.

In *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (April 2007), the Supreme Court identified three factors to look into in order to determine whether there was an apparent reason to combine known elements: (1) interrelated teachings of multiple patents; (2) the effects of demands known to the design community or present in the market place; and (3) the background knowledge possessed by a person having ordinary skill in the art.

In *KSR*, the Supreme Court looked specifically to factor (2) and adopted the District Court's factual determination that there then existed a marketplace that created a strong incentive to convert mechanical pedals to electronic pedals. The Court then concluded that it was obvious to a person of ordinary skill to combine a mechanical pedal with a pivot-mounted pedal position sensor. *Id.* at 1744.

KSR is applicable only when cited references in combination disclose all the limitations in a claim and thus is not controlling in the present application. Nonetheless, Applicants believe that the same reasoning adopted by the Supreme Court in *KSR* should warrant the conclusion in the present application that when the present invention was made, a person of ordinary skill who had a wireless terminal with the Internet access capability would not have been motivated to selectively register images of the accessed sites for later display.

Concurrently submitted with this supplemental response is a declaration by Mr. Masaaki Yamamoto, one of the inventors of the present invention. In the

declaration, Mr. Yamamoto explained the wireless communication industry which existed when the present application was filed in Japan in May of 1999 and the environments then surrounding the industry.

In the declaration, Mr. Yamamoto identified two important constituents in the wireless communication industry back in 1999. He first discussed the wireless terminal which was commercially available when the present application was filed in Japan in May of 1999. He pointed out the hardware limitations of such terminal, especially a small display of the terminal. In fact, the screen having a size of 6 x 8 characters could only have been used to display simple text messages and primitive images.

The subject matter of the present invention is one of the most popular features of the wireless terminal in these days. People enjoy seeing images on their terminals which they downloaded from the Internet. Hence, each of the mobile terminals shows a unique image selected by the user, and the unique image selected by the user for display on the terminal is considered "the face" of the terminal. However, as one can readily imagine, the screen of the 6 x 8 size could not have given the users the ability to display an image so unique to become the face of the terminal.

Mr. Yamamoto then discussed the content provider. Special content providers which carried contents customized to fit on the small displays of the terminals were indispensable for implementation of the i-mode service. Significantly, according to Mr. Yamamoto, there existed only 67 such content providers in 1999. The Examiner can imagine how small the information source was in 1999 which could be accessed by the i-mode terminals. Besides, the data allowed on put on web pages was limited in size to 5 Kbyte at maximum back in 1999. Under this limitation, the content providers had no choice but to limit the contents to simple text messages and primitive images.

As explained above, a unique image selected by the user for display on the terminal is considered "the face" of the terminal. By storing a unique image for


display, a user personalizes or gives a personality to the mobile terminal. However, this personalization of terminals requires an abundance of different and unique images. The content providers which existed in 1999 could not have provided images so unique to allure the i-mode service users to download and store on their wireless terminals for later display as the faces of the terminals.

Using the feature of the present invention, users can give their terminals a personality or a unique face. But the implementation of the feature requires mobile terminals with an expressive display screen and the information source presenting an abundance of unique images. Back in May of 1999, different circumstances existed than today in which the terminals had a black-and-white screen whose screen size was of only 6 x 8 characters, and there were only 67 registered content providers from which only simple text messages and primitive images were available.

Under the circumstances, it is believed that the market which existed in May of 1999 was not ready for the subject matter of the present invention. It is believed that back in May of 1999, no one would have thought of personalizing their wireless terminals, using unique pictures selected and stored for display. Please note that throughout its history, the telephone was a faceless tool. Under the circumstances, a person of ordinary skill who was in the wireless communication industry back in May of 1999 would not have been motivated to selectively register images for later display in the context of browsing.

Respectfully submitted,

Dated: July 26, 2007



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